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| 10/660,538 | 09/12/2003 | Tsutomu Ohishi | 242738US2 | 5339 |

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| EXAMINER |
|---|
| RODRIGUEZ, LENNIN R |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/660,538 | OHISHI ET AL. |
| | Examiner | Art Unit | |
| | LENNIN R. RODRIGUEZ | 2625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>26 March 2009</u>.

2a)☒ This action is **FINAL**.      2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-3,5-7,9-16,18-23,25 and 26</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-3,5-7,9-16,18-23,25 and 26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☒ All    b)☐ Some * c)☐ None of:

         1.☒ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

1.     Applicant's arguments with respect to claims 1 and 14 have been considered but are moot in view of the new ground(s) of rejection. Applicant's argument "Whitmarsh does not disclose or suggest the feature of 'the print request part extracts one or more addresses of the one or more of the plurality of image forming apparatuses having the function included in the print request ....'" is based on a newly submitted limitation that requires new search and consideration.

### *Claim Rejections - 35 USC § 103*

2.     The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3.     Claims 1-3, 5-7, 11, 13-16, 18-21 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitmarsh (US 2002/0101608) in view of Matsueda et al. (US 2001/0040692).

       (1) regarding claims 1 and 14:

       Whitmarsh '608 discloses an image forming apparatus (10 in Fig. 1) comprising:

       an information providing part (workflow application server 14 in Fig. 1) configured to provide, to a client terminal, screen data being used for selecting one or more image forming apparatuses among from a plurality of image forming apparatuses (paragraph [0035] and paragraph [0036], lines 1-4, where the user can select the destination printer

among the ones shown in a list) connected to a network on the client terminal (paragraph [0021], lines 1-7, where the printers are connected through a network to the system),

a print request part (18a in Fig. 1) configured to distribute print data and a print request to one or more of the plurality of image forming apparatuses (paragraph [0021], lines 19-26, where the publisher distributes the print request with the print files to 18b...18d in Fig. 1), wherein, when a print request that has been received includes a name of print data and a function of an image forming apparatus from the client terminal (paragraph [0021], lines 19-26, it contains print file and print request information),

Whitmarsh '608 discloses all the subject matter as described above except an information providing part configured to store, in a storage unit, information including addresses of one or more of the image forming apparatuses which have been selected by associating the information with functions of the selected one or more image forming apparatuses; and

the print request part extracts one or more addresses of one or more of the plurality of image forming apparatuses having the function included in the print request sent from the client terminal from among the selected one or more information apparatuses, and the print request part distributes the print data and a print request to the one or more of the plurality of image forming apparatuses having the function by specifying the extracted one or more addresses.

However, Matsueda '692 teaches an information providing part configured to store, in a storage unit (paragraph [0062], and 203 in Fig. 2), information including

addresses of one or more of the image forming apparatuses which have been selected by associating the information with functions of the selected one or more image forming apparatuses (paragraph [0028] and paragraph [0062]); and

the print request part extracts one or more addresses of one or more of the plurality of image forming apparatuses having the function included in the print request sent from the client terminal from among the selected one or more information apparatuses (paragraph [0028], lines 8-14, where the address is extracted of the selected device), and the print request part distributes the print data and a print request to the one or more of the plurality of image forming apparatuses having the function by specifying the extracted one or more addresses (paragraph [0028, lines 8-14, where the extracted address is that of the desired printer device).

Having a system of Whitmarsh '608 reference and then given the well-established teaching of Matsueda '692 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus and method of Whitmarsh '608 to include an information providing part configured to store, in a storage unit, information including addresses of one or more of the image forming apparatuses which have been selected by associating the information with functions of the selected one or more image forming apparatuses; and the print request part extracts one or more addresses of one or more of the plurality of image forming apparatuses having the function included in the print request sent from the client terminal from among the selected one or more information apparatuses, and the print request part distributes the print data and a print request to the one or more of

the plurality of image forming apparatuses having the function by specifying the extracted one or more addresses as taught by Matsueda '692 because it would allow the system to have a destination and related information of the device to which it will send print data that way it releases the client computer the memory usage of having all that information in its own memory, thus reducing the cost of adding more memory to a client computer.

(2) regarding claims 2 and 15:

Whitmarsh '608 further discloses wherein the information providing part sends screen data for inputting a print instruction to the client terminal (paragraph [0041]-[0042], where via a browser there is provided a screen so that the user can make choices); and

the print request part distributes the print data and the print request when receiving the print instruction from the client terminal (paragraph [0046], lines 1-7).

(3) regarding claims 3 and 16:

Whitmarsh '608 further discloses wherein the information providing part sends screen data used for uploading the print data to the client terminal (paragraph [0038]); and

the image forming apparatus receives the print data when the print data is uploaded from the client terminal (paragraphs [0038]-[0039]).

(4) regarding claims 5 and 18:

Whitmarsh '608 further discloses wherein the screen data includes data for displaying a plurality of image forming apparatuses (paragraph [0043], where the user

can select the destination printer among the ones shown in a list) and corresponding

places for each of the image forming apparatuses (paragraph [0043], where the list

includes publisher address).

(5) regarding claims 6 and 19:

Whitmarsh '608 further discloses wherein the screen data includes data for

displaying a plurality of image forming apparatuses (paragraph [0043], where the user

can select the destination printer among the ones shown in a list) and corresponding

functions for each of the image forming apparatuses (paragraph [0041]).

(6) regarding claim 7:

Whitmarsh '608 discloses all the subject matter as described above except

wherein the print request part distributes the print data and the print request by referring

to the information stored in the storage unit.

However, Matsueda '692 teaches wherein the print request part distributes the

print data and the print request by referring to the information stored in the storage unit

(paragraph [0028, lines 8-14, where the extracted address is that of the desired printer

device) (paragraph [0062], and 203 in Fig. 2).

Having a system of Whitmarsh '608 reference and then given the well-

established teaching of Matsueda '692 reference, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to modify the image

forming apparatus and method of Whitmarsh '608 to include wherein the print request

part distributes the print data and the print request by referring to the information stored

in the storage unit as taught by Matsueda '692 because it would allow the system to

have a destination and related information of the device to which it will send print data

that way it releases the client computer the memory usage of having all that information

in its own memory, thus reducing the cost of adding more memory to a client computer.

(7) regarding claim 11:

Whitmarsh '608 discloses all the subject matter as described above except

wherein the print request part comprises an address obtaining part for obtaining

addresses of the one or more image forming apparatuses connected to a network; and

wherein the print request part distributes the print data and the print request by

using addresses obtained by the address obtaining part.

However, Matsueda '692 teaches wherein the print request part comprises an

address obtaining part for obtaining addresses of the one or more image forming

apparatuses connected to a network (paragraph [0028], lines 8-14, where the address

is extracted of the selected device); and

wherein the print request part distributes the print data and the print request by

using addresses obtained by the address obtaining part (paragraph [0028, lines 8-14,

where the extracted address is that of the desired printer device).

Having a system of Whitmarsh '608 reference and then given the well-

established teaching of Matsueda '692 reference, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to modify the image

forming apparatus and method of Whitmarsh '608 to include wherein the print request

part comprises an address obtaining part for obtaining addresses of the one or more

image forming apparatuses connected to a network; and wherein the print request part

distributes the print data and the print request by using addresses obtained by the address obtaining part as taught by Matsueda '692 because it would allow the system to have a destination and related information of the device to which it will send print data that way it releases the client computer the memory usage of having all that information in its own memory, thus reducing the cost of adding more memory to a client computer.

(8) regarding claims 13 and 26:

Whitmarsh '608 further discloses the image forming apparatus further comprising hardware resources used for image forming processes (Fig. 1, where it has a variety of hardware components), and control services that perform processes of the system side including control of the hardware resources according to a request from an application executed in the image forming apparatus (14 in Fig. 1),

wherein the image forming apparatus is configured to be able to install a plurality of applications separately from the control services (paragraph [0033], where different programs such as job store application can be installed), and the image forming apparatus includes the information providing part and the print request part as an application (paragraph [0043]).

(9) regarding claim 20:

Whitmarsh '608 discloses all the subject matter as described above except wherein the image forming apparatus stores in a memory information including addresses of the selected one or more image forming apparatuses, and

wherein the image forming apparatus distributes the print data and the print request by referring to the information stored in the memory.

However, Matsueda '692 teaches wherein the image forming apparatus stores in a memory information including addresses of the selected one or more image forming apparatuses (paragraph [0028] and paragraph [0062]), and

wherein the image forming apparatus distributes the print data and the print request (paragraph [0028, lines 8-14, where the extracted address is that of the desired printer device) by referring to the information stored in the memory (paragraph [0062], and 203 in Fig. 2).

Having a system of Whitmarsh '608 reference and then given the well-established teaching of Matsueda '692 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus and method of Whitmarsh '608 to include wherein the image forming apparatus stores in a memory information including addresses of the selected one or more image forming apparatuses, and wherein the image forming apparatus distributes the print data and the print request by referring to the information stored in the memory as taught by Matsueda '692 because it would allow the system to have a destination and related information of the device to which it will send print data that way it releases the client computer the memory usage of having all that information in its own memory, thus reducing the cost of adding more memory to a client computer.

(10) regarding claim 21:

Whitmarsh '608 further discloses wherein the print instruction includes an instruction for designating functions to be used for printing the print data (paragraph

[0041]-[0042], where via a browser there is provided a screen so that the user can make choices), and

the print request part selects one or more image forming apparatuses that includes the designated functions from among the selected one or more image forming apparatuses (paragraph [0043], where the user can select the destination printer among the ones shown in a list), and distributes the print data and the print request to the one or more image forming apparatuses that includes the designated functions (paragraph [0046], lines 1-7).

4.      Claims 9-10 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitmarsh (US 2002/0101608) and Matsueda et al. (US 2001/0040692) in view of Shima (JP 2001209503 A, machine translation it's being used for the citations).

(1) regarding claims 9 and 22:

Whitmarsh '608 and Matsueda '692 disclose all the subject matter as described above except wherein the print request part requests a printing part of the image forming apparatus itself to print the print data.

However, Shima '503 teaches wherein the print request part requests a printing part of the image forming apparatus itself to print the print data (paragraph [0009], where with the loop back address the system is able to perform this function).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein the print request part requests a printing part of the image forming apparatus itself to print the print data as taught by Shima '503, in the

system of Whitmarsh '608 and Matsueda '692. With this the development cost are reduced by dispensing with the development of an interface relying on each printing server (English abstract).

(2) regarding claims 10 and 23:

Whitmarsh '608 and Matsueda '692 disclose all the subject matter as described above except wherein the print request part requests the printing part of the image forming apparatus itself to print the print data by using a loop back address.

However, Shima '503 teaches wherein the print request part requests the printing part of the image forming apparatus itself to print the print data by using a loop back address (paragraph [0009], where with the loop back address the system is able to perform this function).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein the print request part requests the printing part of the image forming apparatus itself to print the print data by using a loop back address as taught by Shima '503, in the system of Whitmarsh '608 and Matsueda '692. With this the development cost are reduced by dispensing with the development of an interface relying on each printing server (English abstract).

5.      Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitmarsh (US 2002/0101608) and Matsueda et al. (US 2001/0040692) in view of Aoyagi et al. (US 2002/0032761).

Whitmarsh '608 and Matsueda '692 disclose all the subject matter as described above except wherein the address obtaining part obtains the addresses from MIBs by using SNMP.

However, Aoyagi '761 teaches wherein the address obtaining part obtains the addresses from MIBs by using SNMP (paragraph [0393]).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein the address obtaining part obtains the addresses from MIBs by using SNMP as taught by Aoyagi '761, in the system of Whitmarsh '608 and Matsueda '692. This allows for displaying a network configuration chart that allows easy understanding of port-by-port connections of network devices and the like (paragraph [0013]).

## Conclusion

6.     Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.   Accordingly, **THIS ACTION IS MADE FINAL**.   See MPEP § 706.07(a).   Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action.   In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENNIN R. RODRIGUEZ whose telephone number is (571)270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
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